

REMARKS/ARGUMENTS

In the Request for Reconsideration filed in the present application on June 30, 2006, Applicants provided objective evidence comparing the claimed invention with the closest prior art to prove that the use of dimethyl butanoic acid (DMBA) instead of dimethyl propionic acid (DMPA) in preparing a separable fastener provides a significantly superior separable fastener. In response to Applicants' data the Office mailed an Advisory Action on July 14, 2006. The Office stated the following with respect to Applicants' evidence:

The comparison between Example 1 (page 27, Table 3) utilizing the same amounts of polytetramethyleneglycol, isophorone diisocyanate, diethylaminoethanol, piperazine hexahydrate, hydrazine monohydrate and n-butylamine (the acronyms identified on page 19 in Table 1) as in Comparative Example 1 (page 28, Table 4) except for the use of the claimed 2,2-dimethylol butanoic acid as opposed to the 2,2-dimethylol propionic acid employed in the closest prior art polyurethane of Japanese Patent No. 62-112504 is valid. However, the evaluations reported for Example 1 (page 30, Table 6) and Comparative Example 1 (page 32, Table 8) are based on ratings dependent upon the opinion of the observer and cannot be scientifically corroborated in the absence of objective evidence of the source of the evaluation such as microphotographs.

See paragraph no. 2 on page 2 of the July 14, 2006 Advisory Action.

Applicants submit that the Office's statements in the Advisory Action are incorrect as a matter of law at least because (i) there is no requirement in the law that performance ratings must be "scientifically corroborated," and (ii) the Office provided no authority, and in fact there is none, for the position that ratings based upon the observation of an individual cannot qualify as objective evidence.

Applicants submit that on this basis alone the rejections should be withdrawn and the claims allowed, especially in view of the fact that the Office acknowledged that the comparison of Example 1 and Comparative Example 1 was otherwise "valid" (see page 2, lines 5-11 of the July 14, 2006 Advisory Action).

Regardless of the above remarks, in order to expedite prosecution Applicants submit herewith a Declaration under 37 C.F.R. §1.132. The Declaration includes a photographic comparison of the separable fasteners described in the examples of the present specification. Applicants submit that this additional information makes it clear that the resistance to fiber dropout in washing and resistance to chlorine bleaching agents is substantially superior for a separable fastener made from a DMBA-containing composition in comparison to separable fasteners made with DMPA-containing compositions. Applicants also provided color copies of pictures of the separable fasteners of the declaration to the Examiner.

In paragraph 15 of the Declaration the Declarant states:

It is my opinion that the data described above and summarized in Tables A-C above show that the use of DMBA provides a separable fastener that is significantly superior in comparison to separable fasteners made from DMPA with respect to at least resistance to fiber dropout in washing and resistance to chlorine bleaching agents, and that such a difference would not have been foreseen in the absence of the data provided by the specification of the present application.

Applicants submit that the Declaration should now be entered and considered because the Office had the opportunity to inspect and compare an inventive separable fastener with the separable fastener of the closest prior art during the interview of March 20, 2006. In fact, the Interview Summary even states that the comparative example exhibited “discoloration and balding” in comparison to the inventive example. Applicants thus submit that the Office previously recognized the degree of difference between DMBA- and DMPA-containing separable fasteners and acknowledged that the inventive example is different in comparison to the closest prior art.

Thus, for the reasons stated above, Applicants submit that the data of the original specification prove that the presently claimed invention is significantly superior to the closest

prior art and that the improvement obtained by using DMBA instead of DMPA would not have been foreseen by one of ordinary skill in the art at the time the application was filed.

Allowance of all now-pending claims is respectfully solicited.

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